



Docket No.: SON-3141

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Yasutaka OGASAWARA et al.

Application No.: 10/541,500

Confirmation No.: 2009

Filed: July 7, 2005

Art Unit: 2446

For: SERVICE MANAGING APPARATUS AND  
METHOD, AND SERVICE PROVIDING  
SYSTEM AND METHOD

Examiner: G. W. Li

**REPLY BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a Reply Brief under 37 C.F.R. § 41.41 in response to the Examiner's Answer dated January 5, 2010.

All arguments presented within the Appeal Brief dated October 15, 2009 are incorporated herein by reference. Additional arguments are provided herein.

## I. STATUS OF CLAIMS

### A. Current Status of Claims

A complete listing of the claims with corresponding status is provided as follows:

Claims 1, 3-4, 6-8, 10-11, 13-14, 16-17, 19-21, 23 and 25-39. (Rejected).

Claims 2, 5, 9, 12, 15, 18, 22 and 24. (Cancelled).

### B. Claims On Appeal

Appellant appeals the final rejection of claims 1, 3-4, 6-8, 10-11, 13-14, 16-17, 19-21, 23 and 25-39.

## II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for consideration in this appeal, with separate arguments as noted in the following sections, are as follows:

Whether the Examiner erred in rejecting claims 1, 3-4, 6-8, 10-11, 13-14, 16-17, 19-21, 23 and 25-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,266,649 to Linden et al. (“Linden”) in view of U.S. Pat. No. 5,933,811 to Angles et al. (“Angles”), and further in view of U.S. Pub. No. 2004/0024652 to Buhse et al. (“Buhse”).

Whether the Examiner erred in rejecting claims 34-39 under 35 U.S.C. § 103(a) as being unpatentable over Linden, Angles, and Buhse, and further in view of U.S. Pat. No. 6,996,094 to Cave et al. (“Cave”).

These issues are discussed in the following section, with subsections corresponding to the separate arguments.

### III. ARGUMENT

#### III.A Introduction.

In the Final Office Action of December 8, 2008, the Examiner erred in rejecting claims 1, 3-4, 6-8, 10-11, 13-14, 16-17, 19-21, 23 and 25-33 under 35 U.S.C. § 103(a) as being unpatentable over Linden in view of Angles, and further in view of Buhse, and erred in rejecting claims 34-39 under 35 U.S.C. § 103(a) as being unpatentable over Linden, Angles, and Buhse, and further in view of Cave.

Consistent with the grouping of claims in the following sections, these rejections are variously deficient as noted in the separate arguments.

#### III.B Linden, Angles, and Buhse fail to disclose or suggest the features recited in claims 1, 6-8, 13-14, 16, 20-21 and 25-33.

Claim 1 recites: *[a] service managing apparatus for managing an information transmission service in which digital content is sent in real time between communication devices connected to each other over a network, the apparatus comprising:*

*a communication controlling means for controlling the communication with each of the communication devices;*

*an information registering means for maintaining registration information on more than one piece of digital content available from those of the communication devices that are registered as an information provider; and*

*an information managing means for dynamically generating, based on the registration information, choices-window information from which selection is made of a desired one of the plurality of pieces of offered digital content by those of the communication devices that are to receive the desired piece of offered digital content,*

*the information managing means updating, when the registration information has been updated based on updating information reflecting the current status of the information provider, the choices-window information on the basis of the updated registration information, wherein the*

*choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time, and wherein the communication controlling means controls the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider, with the desired piece of offered digital content being provided in real time when it is indicated as currently available in real time.*

These claimed features accommodate the sending of digital content between communications devices that are connected to each other. That is, the digital content itself is selected and then received by one of the communication devices, with the digital content itself being provided to that communication device from another of the communication devices (the information provider).

Independent claim 1 recites a service management apparatus that manages an information transmission service in which the digital content is sent in real time between the so-connected communication devices. Pursuant to this, an information registering means registers the digital content available from those of the communication devices that are registered as an information provider. The information managing means dynamically generates choices-window information for selection of a desired piece of offered digital content for the communication device that is to receive the desired piece of offered digital content. The communication controlling means controls the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider. Additionally, the choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time. When this is the case, the communication controlling means controls the connection so that the digital content can be provided in real time between the respective communication devices.

Essentially, the Examiner relies upon a reference (Linden) disclosing a web site that allows collaborative recommendations of books and other items. The Examiner analogizes the

provision of book recommendations on the web site to Applicant's claimed sending of digital content. While a recommendation itself may be a piece of "digital content" in a general sense, for reasons outlined in detail in the following sections, the Examiner's attempt to map this reference to Appellant's claimed invention breaks down in several instances, and for that reason the Examiner's rejection of the claims must be reversed.

Still further, it is clear, and further evident upon review of the Examiner's Answer, that the claims are being considered in piecemeal fashion. The claims must be considered as a whole, and that exercise has not been undertaken in the Examiner's rejections of the claims.

**III.B.1. *Linden fails to address in any way controlling a connection between two respective communication devices so that the digital content can be provided from one communication device to the other.***

Linden fails to address in any way controlling a connection between two respective communication devices so that the digital content can be provided from one communication device to the other. As such, there are also various claimed, particular features in support of such digital content provision that are wholly absent from Linden.

Linden discloses a system that allows for collaborative recommendations wherein computer users may rate various items that are available through the web site/server. The computer users do not register "digital content" that is to be provided by their computer, nor do they select from among the offered digital content so that it can be sent from one of the computers to another of the computers that may be connected through the network.

Linden at least fails to disclose or in any way suggest "*wherein the communication controlling means controls the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider, with the desired piece of offered digital content being provided in real time when it is indicated as currently available in real time,*" as claimed by Appellant.

At best, one “communication device” in Linden may post a recommendation about some content (e.g., a paperback book, a chair, etc.) that is available from a separate service provider. This is obviously not the provision of digital content. Nor is it the provision of digital content, or controlling connection between one communication device and another communication device to provide digital content there-between in real time.

Presumably, according to the apparent stance in the Action, the “recommendation” itself, or the link to the title of the book, or the like, is the “digital content”. However, in these instances, the recommendation is merely posted by the server, with the server conveying the information to another user browsing available content. **There is never controlling of a connection between the communication devices (the recipient and the provider)**, let alone in response to selection of content, or further in response to selection based upon indicated availability of the digital content from the information provider communication device in real time. With this degree of deficiency, it is clear that Linden has little, if any, disclosure pertinent to Appellant’s claimed invention.

To clarify, the claim is reproduced as follows to highlight the various areas where the attempted analogy between Linden and the claim breaks down, with the claim language in italics and Appellant’s commentary in bold: Specifically, claim 1 recites: *[a] service managing apparatus for managing an information transmission service in which digital content is sent in real time between communication devices connected to each other over a network, the apparatus comprising:*

*a communication controlling means for controlling the communication with each of the communication devices;*

*an information registering means for maintaining registration information on more than one piece of digital content available from those of the communication devices that are registered as an information provider (these features are not shown in Linden. If the “digital content” is the title or the recommendation, the analogy fails as the claim requires registration of the digital content as being available from the registered information provider); and*

*an information managing means for dynamically generating, based on the registration information, choices-window information from which selection is made of a desired one of the plurality of pieces of offered digital content by those of the communication devices that are to receive the desired piece of offered digital content,*

*the information managing means updating, when the registration information has been updated based on updating information reflecting the current status of the information provider, the choices-window information on the basis of the updated registration information, wherein the choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time (these features are not shown in Linden. If the “digital content” is the title or recommendation, that information is merely presented by the web site server to another user. There is never any indication whether “the communication device that is the information provider” can provide the offered digital content in real time. There is no maintenance of the “current status of the information provider” at all, let alone in support of communicating whether the registered communication device can provide the offered digital content in real time), and*

*wherein the communication controlling means controls the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider, with the desired piece of offered digital content being provided in real time when it is indicated as currently available in real time (these features are not shown in Linden. There is no controlled connection between communication devices (provider and receiver) or, of course, any indication whether the offered digital content is available in real time or provision of digital content accordingly.).*

#### Examiner's Answer

In response to the deficiencies articulated above, the Examiner's Answer states that Linden (1) teaches controlling a connection flow information based upon user input; (2) that the Examiner interprets the recommendation of a book title, music title or video title as the digital

content; (3) that this digital content is available to the user upon user input; (4) that the “web server 32 controlling the information flow between the client user and the user profiles which client users and user profile are part of communication devices”; and (5) that the recommendation on user interests are stored in the user profile.

Applicant believes that this response is merely representative of the prior position as set forth in the Final Office Action, and that the above-described deficiencies remain. At best, the recommendations would remain resident at the web server and would merely be displayed to a user accessing a corresponding web page. Presuming that the position that the “recommendation” is a proper example of the claimed “digital content” (per points (2) and (3) of the Examiner’s Answer), there are still remaining deficiencies in the reference.

With respect to point (1) in the Examiner’s Answer, the offered example of the recommendation that is submitted by communication device #1 at the web server, and then stored by the web server for later possible access by communication device #2 is not a disclosure of a connection between the two communication devices. Thus, it is clearly no example of “*control[ing] the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider, with the desired piece of offered digital content being provided in real time when it is indicated as currently available in real time.*” First, there is never a connection between communication devices #1 and #2 in this example. Additionally, the information is not provided from one communication device to the other in real time, and is never “*indicated as currently available in real time*” as the information flow does not occur in that fashion.

It also cannot be stated that Linden discloses “*registration information on more than one piece of digital content available from those of the communication devices that are registered as an information provider,*” as claimed by Appellant. The claim states that the registration information is on the actual pieces of digital content. There is no disclosure in Linden of any such registration. Again, the recommendations that might be available from the web server, even if they are construed as “digital content” cannot be fairly stated as being registered as such.

Still further, and connected to this recitation, there is also no disclosure or suggestion of “*the information managing means updating, when the registration information has been updated based on updating information reflecting the current status of the information provider, the choices-window information on the basis of the updated registration information, wherein the choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time.*” There is no mention of registering the “digital content” tracking the status of the information as to whether the “digital content” can be currently be provided in real time by the information provider. At best, the “information provider” would submit a recommendation, and it would sit at the web server for some future access. There is no continued updating of registration information to determine whether the “recommender” would provide the digital content in real time (indeed, this never occurs as has already been stated above).

Per the Examiner’s point (5) above, simply “storing” the recommendation at the web server is not a disclosure of the detailed registration of availability of digital content, and corresponding provision of that content by the communication device that is the information provider. Additionally, point (4) states “web server 32 controlling the information flow between the client user and the user profiles which client users and user profile are part of communication devices.” This is very unclear, but if the Examiner’s Answer now contemplates that the web server itself is the information provider, then this renders the attempted mapping to the claims even more deficient. Clearly, the web server does not register itself as the communication device that is the information provider. Also, the web server is not providing the “digital content” according to the remainder of the Examiner’s analysis.

**III.B.2. *The Examiner erroneously alleges that claim 1 does not require separate communication devices, one providing digital content and the other receiving digital content, as well as controlling the connection between the former and latter communication devices.***

The Examiner erroneously alleges that claim 1 does not require separate communication devices, one providing digital content and the other receiving digital content, as well as establishing

connection between the former and latter communication devices. (See, e.g., Advisory Action dated April 6, 2009, at p. 2, In response to Argument E). This is an inaccurate assertion. It is quite clear that the claims recite two separate communication devices, one being the communication device that is the information provider, and the other being the communication device that receives the desired piece of digital content.

For ease of reading, various relevant portions of the claim that support Appellant's position are reproduced as follows: "[a] service managing apparatus for managing an information transmission service in which digital content is sent in real time between communication devices connected to each other over a network ... comprising ... maintaining registration information on more than one piece of digital content available from those of the communication devices that are registered as an information provider ...[wherein] selection is made of a desired one of the plurality of pieces of offered digital content by those of the communication devices that are to receive the desired piece of offered digital content [and] ... choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time, and wherein the communication controlling means controls the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider ...."

The above demonstrates that the features are indeed well represented in the claims, as well as the extent to which the claim and the Linden reference are being misconstrued to attempt to read the claims on the reference.

#### Examiner's Answer

With regard to this section, the Examiner's answer makes specific reference to the disclosure, by the Angle reference, of a situation where an advertisement provider communicates an advertisement embedded within an electronic document (e.g., web page). First, it is clear that this type of operation is wholly distinct from that in the Linden system, wherein separate users can make

recommendations that are stored by the web server. There is no articulation as to how one would modify such an approach according to any teaching of the Angle reference. Second, even presuming that the proposed “combination” is in any way proper, it would still fail to yield several features recited above, as there would still be no example of “[wherein] selection is made of a desired one of the plurality of pieces of offered digital content by those of the communication devices that are to receive the desired piece of offered digital content [and] ... choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time,” as claimed by Appellant. In Angle, there is no “selection” of the embedded advertisement by the information recipient user, and there is certainly no such selection with corresponding indication whether the “communication device” can currently provide the offered digital content in real time.

*III.B.3. Even if the “recommendation” or “title” of work displayed on a Linden website is construed as “digital content”, the Linden reference remains variously deficient in failing to disclose the type of choices-window information and corresponding communication control claimed by Appellant.*

Even if the “recommendation” or “title” of work displayed on a Linden website is construed as “digital content”, the Linden reference remains variously deficient. For example, Linden does not disclose or suggest “[wherein the choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time,” or “[wherein the communication controlling means controls the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider, with the desired piece of offered digital content being provided in real time when it is indicated as currently available in real time,” as claimed by Appellant.

Linden discloses generating recommendations that are specific to a shopping cart for offline purchase following a checkout process. (See 6:52-67 of Linden). This is not an example of registering a device as an information provider of digital content, or providing an indication that the

corresponding digital content is available in real time, or of providing the desired piece of offered digital content in real time, from the registered communication device that is the information provider to the registered communication device that is to receive the digital content.

The Action seeks to address this deficiency by claiming that the server filters what is ultimately shown to the other user as being available. Again, this ignores the information provider and information recipient roles of the two communication devices. In no way does the recommendation of a product constitute “*wherein the choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time,*” as claimed by Appellant.

In Linden, the only analogous window-choices would be the content available from the server. This is not an example of offered digital content, and “choices” are not presented in the claimed fashion. Moreover, real time provision of the digital content is not in any way addressed, let alone real time provision of the digital content from the communication device (rather than from the server as is the case in Linden).

#### Examiner’s Answer

In response to Appellant’s stating that Linden fails to disclose the type of “choices-window information and corresponding communication control claimed by” Appellant, the Examiner’s Answer refers to the filtering of a list of content that is presented to a user depending upon whether items “(1) have already been purchased or rated by the user, (2) have a negative score, or (3) do not fall within the designated product group (e.g., books) or category” (Examiner’s Answer, at p. 27, citing Linden 15:36-40). The Answer then states that when the user selects one of the recommended music or audio titles, the selected items information will be sent to the user. Appellant submits that this is another failure in the analysis. Clearly, the selection of the book or music in this instance is not the provision of digital content from the “information provider” but is instead merely selecting a book or music title for which the web server has information (pursuant to a purchase by the user). This would still fail to disclose “*wherein the choices-window information*

*includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time,”* as claimed by Appellant.

**III.B.4. Angles and Buhse do not remedy the deficiencies of Linden.**

Angles does not remedy the deficiencies of Linden. Angles discloses a system for delivering customized advertisements within interactive communication systems. When a user of a “consumer computer” accesses an offering from a content provider computer, a corresponding advertisement provider computer generates a custom advertisement based upon the user’s profile, and combines that custom advertisement with the offering being provided by the content provider computer for display by the consumer computer.

Although some “content” is arguably delivered from the advertisement provider computer to the consumer computer (*i.e.*, the customized ads, presumably within web pages or the like that are accessed through the content provider computer), as with the Linden reference there is clearly no disclosure or suggestion of the features of having choices-window information *from which selection is made of a desired one of the plurality of pieces of offered digital content by those of the communication devices that are to receive the desired piece of offered digital content.*” Even under the strained interpretation of this reference that appears to have been maintained by the Examiner in the Action, there is no reasonable instance of selection of the desired content in a choices window as claimed.

The Action references prior registration of a user with the advertisement provider as allegedly disclosing this feature. Even assuming that this is disclosed, this is merely a prior registration in which, perhaps, a user enters profile information or preferences. It has nothing to do with available digital content from the registrant or the selection of the same, and the reference to this registration process only further highlights the deficiency of the combination offered by the Examiner.

It bears repeating that the claims actually recite “*wherein the choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time,*” and “*wherein the communication controlling means controls the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider, with the desired piece of offered digital content being provided in real time when it is indicated as currently available in real time,*” and that neither reference contains any disclosure whatsoever of these claimed features.

In addition to the above-noted inadequacies, the Action notes that the combination of Linden together with Angles still does not disclose maintaining registration information on more than one piece of digital content from registered communication devices, offered digital content in real time, and offered content being provided in real time when it is indicated as being offered in real time. (See Office Action, at p. 9).

Buhse remedies neither the deficiencies noted in the Action nor the additional deficiencies noted above regarding Linden and Angles. Buhse discloses a digital distribution platform that provides a common messaging system that is said to be flexible while at the same time providing digital rights management enforcement. Buhse clearly describes a system wherein a variety of devices communicate with the system to review and acquire content from the system, not from other devices registered with the system. There is no mention of the establishment of connections between separate communication devices of information providers and information recipients wherein the content is then provided from the information provider communication device to the communication device that is to receive the digital content. The available “digital products” are merely those available through the system, not from one communication device to the other as claimed.

Thus, since Linden, Angles, and Buhse, whether taken alone or in combination, fail to yield the claimed features recited in Appellant’s claim 1, Appellant submits that a *prima facie* case of obviousness is not present for that claim.

For reasons similar to those provided regarding claim 1, independent claims 8, 14 and 21 are also neither disclosed nor suggested by the relied-upon references.

It is also noted that, although the absence of claimed features from even the combination of references is sufficient to draw a conclusion that the *prima facie* case of obviousness has not been presented, the combination itself is faulty. There is no logic or clear presentation as to how these references could possibly be combined in the fashion offered in the Action, as they each are in different technology areas and each solve wholly different problems.

#### Examiner's Answer

Regarding this section, the Examiner's Answer apparently alleges that Linden discloses the "selection of desired content in a choices-window", which discloses Appellant's claimed features when combined with Angles teaching of a registration process and provision of advertising between the consumer computer and the provider computer. (Examiner's Answer, at p. 28).

It is believed that the deficiencies of Linden and Angles are set forth above. However, even accepting this view of the proposed combination as set forth in the Answer, the disclosed registration in Angles is merely a prior registration where at best a user enters profile information or preferences, as noted above. It has nothing to do with available digital content from the registrant or the selection of the same, and the reference to this registration process only further highlights the deficiency of the combination offered by the Examiner.

Furthermore, Linden clearly fails to disclose the particular type of choices-window information claimed by Appellant. In lieu of the distilled general reference to "choices-window" information as mentioned in the Answer, it is reiterated that the claims actually recite "*wherein the choices-window information includes information indicative of whether the communication device that is the information provider can currently provide the offered digital content in real time,*" and "*wherein the communication controlling means controls the connection between the communication device that receives the desired piece of offered digital content and the*

*communication device that is the information provider, with the desired piece of offered digital content being provided in real time when it is indicated as currently available in real time.*” There references fail to disclose these features, alone or in any combination.

III.C Linden, Angles, and Buhse fail to disclose or suggest the features recited in dependent claims 3 and 10.

Appellant’s claim 3 recites “[t]he apparatus according to claim 1, wherein the information managing means generates the choices-window information from which selection is available only for digital content that can currently be provided in real time.”

The Action alleges that Linden discloses these claimed features, with a vague reference to a passage indicating that a filtered list can be shown to a user. The cited listing has nothing to do with whether digital content can currently be provided in real time and has no bearing on what is claimed by Appellant.

The Examiner’s Answer repeats a similar reference. However, even if the “recommendation” itself is considered as the example of the “digital content”, there would still be a failure to disclose what is claimed. The choices-window information allows for selection from digital content that “*can currently be provided in real time.*” This means that the user would observe a list and be accommodated with the opportunity to select a digital content item available in real time. By contrast, the “recommendation” or the corresponding list following a search query is already merely displayed in Linden. This is not an indication of availability in real time, it is the actual “digital content” itself, already provided (i.e., the recommendation, etc., is already being displayed). Regardless, it is not a listing of items that can currently be provided in real time.

III.D Linden, Angles, and Buhse fail to disclose or suggest the features recited in dependent claims 4, 11, 17 and 23.

Appellant's claim 4 recites “[t]he apparatus according to claim 1, wherein the updating information includes types of more than one media which can be used for the real-time provision of the offered digital content.”

The Action alleges that Buhse teaches these claimed features, but this is not correct. As noted, the claimed features offer an indication of types of media that are available. The passage cited in the Action as evidence of disclosure of these features in Buhse merely notes that platform independent content is provided. This is not what is claimed by Appellant. First, as noted above, Buhse merely discloses a system that offers content to system users. There is no connection of information provider devices to information recipient devices or any kind of assessment as to whether any content can be provided there-between, real time or otherwise. It follows that there is clearly no disclosure or suggestion of updating information that includes more than one media type that can be used for real time provision of the offered digital content.

The Examiner's Answer refers to similar portions of Buhse, in particular paragraph [0221]. However, these passages merely state that once content is purchased it is provided in “device independent” fashion, meaning that any number of different rendering (playback) devices may be used. This does not in any way disclose a choices-window scenario wherein multiple different media types are selectable by the user. Instead, it merely indicates that the system can allow various different devices to “log in” and then accommodate the requirements of whatever particular device is logged in. Again, Appellant's claimed features are not disclosed or taught by the reference.

III.E        Linden, Angles, and Buhse fail to disclose or suggest the features recited in dependent claim 19.

By way of example, Appellant's claim 19 recites: “[t]he system according to claim 14, wherein:

*the updating information includes information indicative of the position of the communication device which sends the offered digital content; and*

*the communication controlling means controls, based on the position information, the connection between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider.”*

The Action alleges that column 7, lines 20-39 of Linden offer an example of these claimed features. This passage merely indicates that a web site may have a user profile database. There is no mention of any kind regarding the indication of the position of the communication device that sends the offered digital content, or the related control of the connection based upon this position information.

The Examiner’s Answer does not clarify how any of the relied upon references might be construed as offering these claimed features. (Examiner’s Answer, at p. 30). For example, the Answer states that “Linden teaches based on the user selection (user position information) to choose the recommended music or video titles.” (Id.). It is not understood how this discloses information indicative of the position of the communication device which sends the offered digital content. With regard to Buhse, there is again reference to “rendering device independent” but this also says nothing about the position of the communication device which sends the offered digital content (indeed, as noted, Buhse is a system that provides content, there is no separate communication device that sends the digital content, and certainly no ascertaining of the position of such a (non-existent) device).

Accordingly, Appellant respectfully requests reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) as being unpatentable over the combination of Linden, Angles, and Buhse.

III.F        Linden, Angles, Buhse, and Cave fail to disclose or suggest the features recited in claims 34-39.

Claims 34-39 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Linden, Angles, and Buhse, and further in view of U.S. Pat. No. 6,996,094 to Cave et al. (“Cave”). This rejection is traversed.

These claims variously depend from the independent claims discussed above, and therefore incorporate the features recited therein and absent from the relied-upon references for the noted reasons. Cave does not remedy these deficiencies.

Moreover, the dependent claims also separately recite features that are not disclosed or suggested by the combination of references. For example, claim 34 recites: “[t]he apparatus according to claim 1, wherein the communication devices are voice over internet protocol devices, and wherein when selection is made of a desired one of the plurality of pieces of offered digital content, the communication controlling means establishes a session between the communication device that receives the desired piece of offered digital content and the communication device that is the information provider to accommodate providing the offered digital content in real time.”

Cave does not disclose or suggest these claimed features. At best, Cave merely discloses that VOIP devices are known in a general sense, with no indication whatsoever of providing the above-recited features of claim 34. That is, there is no mention of responding to a selection of a desired piece of offered digital content available from a VOIP communication device by establishing a session between the selecting and providing VOIP communication devices to accommodate providing the digital content in real time. The Examiner’s Answer seeks to address but does not remedy these deficiencies, merely reiterating that Cave discloses VOIP and that the claimed features “would have been obvious”. Notwithstanding the motivation issues, the failure to disclose the above-described features mandates reversal of these grounds of rejection.

A review of the references and record also manifests that there has been no assessment of the differences between these claims and the relied-upon references, and no assessment whatsoever as to how the Cave reference could possibly be combined with the other relied-upon references. Even with the understanding that an explicit motivation to combine the references may

not necessarily be required, there is no technical sense as to how the artisan would ever combine the references in the proffered fashion. At best, the rejection of these claims amounts to a hind-sighted, patchwork attempt to reconstruct Appellant's claimed invention.

The remaining dependent claims 35-39 are similarly neither disclosed nor in any way suggested by the relied-upon references. It is also noted that there has been no assessment as to how yet another disparate reference would be combined with the remaining references. The original combination is faulty, and the attempted addition of the Cave reference only exacerbates the problems with the proposed combination.

\* \* \* \*

For the foregoing reasons, Appellant respectfully requests reversal of the Examiner's rejection of claims 1, 3-4, 6-8, 10-11, 13-14, 16-17, 19-21, 23 and 25-33 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Linden, Angles, and Buhse, and the Examiner's rejection of claims 34-39 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Linden, Angles, Buhse, and Cave.

The claims are considered allowable for the same reasons discussed above, as well as for the additional features they recite.

Reversal of the Examiner's decision is respectfully requested.

Dated: March 1, 2010

Respectfully submitted,

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